

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-6, 8, and 10-17 remain in the application. Claims 1, 2-6, 8, and 10-15 have been amended. Claims 7 and 9 are canceled.

Dependent claims 2-6, 8, and 10-15 have been amended to clarify the features and language in these claims, and to be consistent with the changes to independent claim 1. Support for the changes is found in the previously presented claims.

In the second paragraph under "Claim Rejections-35 USC § 102" on page 2 of the above-identified Office Action, claims 1-17 have been rejected as being anticipated by Frech et al. (US 6,043,724) (hereinafter "Frech") under 35 U.S.C. § 102(b), or in the alternative, as obvious over Frech under 35 U.S.C. 103(a).

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found in the previously presented claims.

More particularly, claim 1 has been amended to recite that the filter has first and second capacitors which are both an integral part of the integrated circuit. Neither capacitor is located outside the integrated circuit. The dependent claims have been amended to be consistent with the changes to independent claim 1.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, an integrated circuit, having:

a radio-frequency (RF) filter device having first and second capacitors connected to the lines and being completely integrated in the integrated circuit for preventing and restricting a propagation of high-frequency interference signals through the lines. (emphasis added)

According to the present invention there is provided an integrated circuit which has integrated in it an RF filter device which can prevent or restrict the propagation of high-frequency interference signals through lines carrying DC voltages or low-frequency voltages. As a result, interference with the operation of the integrated circuit and/or of other integrated circuits or of other components of the system

containing the integrated circuit can be prevented in a very simple yet extremely effective manner.

The provision of the RF filter device with first and second capacitors integrated in the integrated circuit at least partially obviates the need to provide external filters and/or to use particular circuit layouts.

The Frech reference discloses a two-stage power noise filter having **on and off chip capacitors**. In Frech the **first stage capacitor is located off-chip and the second stage capacitor is located on-chip**. For example, see col. 2, lines 62-64. This is best shown in Fig. 1 of Frech in which the first stage capacitor CMCM is located off-chip (see col. 3, lines 35-36). Further, Frech in claim 1 (lines 7-8) emphasizes the importance of this feature by stating "a first stage off-chip capacitor and a second stage on-chip capacitor." The second stage capacitor CVCO is located on-chip as shown in Fig. 1. The structure of the low pass filter "minimizes all off-chip parasitic elements (R and L) . . ." (see col. 2, lines 54-55). Thus, it is apparent that Frech does not disclose an RF filter device (with first and second capacitors) that is completely located in the integrated circuit which it is constructed to protect as claimed.

Clearly, Frech does not show "a radio-frequency (RF) filter device having **first and second capacitors** connected to said lines and being completely integrated in the integrated circuit for preventing and restricting a propagation of high-frequency interference signals through said lines" (emphasis added) as recited in claim 1 of the instant application.

The Examiner has acknowledged that Frech is deficient in that it does not disclose that the capacitor CMCM is part of and integrated in the integrated circuit and has unsuccessfully attempted to overcome this deficiency by alleging that placing the capacitor on chip would be "a matter of design expedient...depending upon a particular application in which the circuit of Frech et al. is to be used." The Examiner then erroneously proceeds to conclude, without showing any justification whatsoever in the prior art, that "[i]t would have been obvious" to place the capacitor (CMCM) on the chip

(4) Such a conclusion is based purely on a hindsight reconstruction of the prior art after having read applicants' disclosure and is mere conjecture on the part of the Examiner without any support in the prior art. The Examiner's basis and reasoning for rejecting the claims under 35 USC 103 is faulted and improper, and is nothing more than arbitrary wishful thinking by the Examiner upon recognizing that the primary Frech reference is deficient in a claimed feature of

the instant invention. Moreover, the off-chip location of the second capacitor as disclosed in Frech is an essential part of Frech's invention and to arbitrarily relocate the capacitor on the chip (merely because the Examiner has read it in applicants' disclosure) would essentially destroy the viability of Frech.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing

of combinability, in whatever form, must nevertheless be "clear and particular." Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Frech to modify the circuit as suggested by the Examiner.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the *applicants* disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Frech to arrive at the claimed invention. Further, the Examiner has not shown the requisite motivation from some

teaching, suggestion, or inference in Frech or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the Frech reference.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 1-6, 8, 10-17 are solicited.

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Reply to Office action of 9/1/04

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested, as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

If an extension of time for reply is required, petition for extension is herewith made.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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FDP/bb

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